

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

APPELLANT'S REPLY BRIEF

APPELLANT: Katrin Reisinger CONFIRMATION NO. 3984
SERIAL NO.: 10/797,494 GROUP ART UNIT: 3628
FILED: March 10, 2004 EXAMINER: Daniel Vetter
TITLE: APPARATUS FOR AUTOMATIC PRODUCT CODE ENTRY
 INTO A MAIL-PROCESSING DEVICE

MAIL STOP APPEAL BRIEF- PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

S I R:

In accordance with the provisions of 37 C.F.R. §41.41, Appellant herewith submits her Reply Brief in response to the Examiner's Answer dated November 28, 2008.

REPLY ARGUMENT

In this Reply Brief, Appellant will respond to the Response to Argument portion of the Examiner's Answer, which begins at page 10 of the Examiner's Answer.

In Appellant's Main Brief, Appellant argued that it is a relevant fact to the alleged obviousness of the claims on appeal is that the United States Postal Service (USPS), although long ago floating the possibility of requiring the use of product codes in the franking imprint for mail items in the United States, has still not implemented such a requirement. In response, the Examiner stated the test for obviousness is not whether a particular feature of a claim being evaluated is required to be in use, or even whether it is currently in use. The Examiner stated the test is whether or not the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time of the invention.

Appellant of course does not disagree with this basic statement of the law, but does not believe it refutes Appellant's arguments concerning the use of the USPS minutes as an obviating reference, since those arguments directly concern analyzing the claims on appeal "as a whole."

This position of the Appellant is related to the arguments that the early filing date of the Uno reference also is relevant to assessing obviousness under 35 U.S.C. §103(a). As the Examiner stated in Section B at page 11 of the Answer, "contentions that the reference patents are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references." The reason why Appellant argued that the USPS minutes and the Uno reference are supportive of patentability of the subject matter

on appeal, rather than a basis for precluding patentability is precisely *because* they demonstrate a long standing problem with no solution.

The USPS minutes are evidence that the use of product codes has been considered as a requirement by USPS for many years, without implementation. Since the Uno reference precedes the USPS minutes, this is also evidence that those of ordinary skill in the field, having knowledge of the USPS minutes, are also presumed to have knowledge of the Uno reference. Nevertheless, no implantation of requirements for product codes in the United States has occurred, and the Examiner has been unable to site any more relevant prior art that is more contemporaneous with the filing date of the present application, that even considers such implementation.

Appellant's point is not *simply* that the Uno reference has an old filing date, and is not *simply* that the USPS has many years ago proposed the use of product codes but still has not implemented any requirements relating thereto. Appellant's point is that if this (alleged) evidence of obviousness is the *only* evidence of obviousness that the Examiner has been able to compile, the aforementioned circumstances associated with both of those references are more persuasive in support of patentability than in support of precluding patentability.

Lastly, Appellant argued that the Uno reference is concerned only with mailed items making use of stamps, rather than the computerized printing of a franking imprint, and the Examiner, in the sentence bridging pages 11 and 12 of the Answer, responded by stating that the Uno reference recognizes that some mail pieces will need to be marked "postage due" because they lack sufficient funds for delivery. This is precisely why an attempted retroactive application of the Uno reference to the

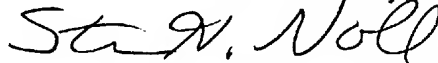
generation and printing of product codes is clearly a result of hindsight. A product code, in order to be useful, and as described in the USPS minutes, must necessarily be printed together with and simultaneously with the franking imprint, otherwise the purpose of the product code, namely to identify the type of mail services being implemented, is not served. A later-added product code, such as by adding a product code to a "postage due" letter, would be useless, since the vast majority of letters would then proceed without a product code. Since the Uno reference deals with the computerized printing of a franking imprint only under very unusual and rare circumstances, it is impractical to believe that a person of ordinary skill in the relevant field would consider the Uno reference as having any utility for generating and printing product codes as described in the USPS minutes.

For these reasons, as well as the reasons set forth in Appellant's Main Appeal Brief, Appellant respectfully submits the rejections of the claims on appeal are improper, and reversal thereof is respectfully requested.

An oral hearing is not being requested, and therefore this appeal is ready for submission to the Board of Patent Appeals and Interferences.

The Commissioner is hereby authorized to charge any additional fees which may be required, or to credit any overpayment to account No. 501519.

Submitted by,



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